



Paper No. 19

KENYON & KENYON  
ONE BROADWAY  
NEW YORK NY 10004

**COPY MAILED**

**OCT 22 2003**

**OFFICE OF PETITIONS  
ON PETITION**

In re Application of  
Li, et al.  
Application No. 09/750,779  
Filed: January 2, 2001  
Attorney Docket No. 12013/55202  
For: CONTROLLED DELIVERY OF  
THERAPEUTIC AGENTS BY INSERTABLE  
MEDICAL DEVICES

This is a decision on the reconsideration petition under 37 CFR 1.78(a)(6), filed September 22, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of prior-filed provisional Application No. 60/173,743, filed December 30, 1999.

Generally, a claim of benefit under 35 U.S.C. 119(e) is required to be filed during the pendency of the nonprovisional application that seeks to claim the invention disclosed in an earlier-filed provisional application.<sup>1</sup> However, when the nonprovisional application is filed on or after November 29, 2000, as is in the instant case, the claim of benefit must be filed **not merely** during the pendency of the nonprovisional application, **but** within either 4 months of its filing date, or 16 months of the filing date of the provisional application, whichever is later.<sup>2</sup>

The claim of benefit submitted with the instant petition is filed during the pendency of the nonprovisional application, but subsequent to May 2, 2001.<sup>3</sup> Such a delayed claim of benefit under 35 U.S.C. 119(e) may be accepted under a petition that includes:

- (1) The claim of benefit (in the form of a specific reference to the provisional application) in an application data sheet or in the first sentence of the specification following the invention title, unless previously submitted;

---

<sup>1</sup> Assuming the following conditions are also met: (1) the nonprovisional application is filed within 12 months of the filing date of the provisional application; (2) the provisional application is entitled to a filing date, has at least 1 common inventor as that named in the nonprovisional application, and discloses that common inventor's invention which is claimed in at least 1 claim of the nonprovisional application; (3) the basic filing fee for the provisional application has been paid. 35 U.S.C. 119(e)(1); 37 CFR 1.78(a)(4).

<sup>2</sup> 37 CFR 1.78(a)(5)(ii). In the instant case, the claim for benefit must be filed no later than May 2, 2001 (4 months after the January 2, 2001 filing date of the instant nonprovisional application), which is later than April 30, 2001 (16 months after the December 30, 1999 filing date of the provisional application).

<sup>3</sup> See *supra* note 2.

- (2) The \$1,300 surcharge set forth in 37 CFR 1.17(t);<sup>4</sup>
- (3) A statement that the entire delay (between the time the claim of benefit was due and the filing of the claim) was unintentional.<sup>5</sup>


The petition meets the above requirements and is thus granted.

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 119 and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to Technology Center Art Unit 1632 for further examination and for processing and consideration by the Examiner of applicant's claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (5) for the benefit of priority to the prior-filed provisional application. The Examiner will also consider the amendment after final, filed August 20, 2003.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.

  
Frances Hicks  
Lead Petitions Examiner  
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

---

<sup>4</sup> 37 CFR 1.78(a)(6)(ii). The fee has been charged to Deposit Account No. 11-0600 as authorized in the petition.

<sup>5</sup> 37 CFR 1.78(a)(6)(iii); contained in petition.